

**Remarks**

The Applicant thanks the Examiner for the consideration shown to the present application. Claims 1-21 are pending and stand rejected. Claims 18 and 20 are amended herein to correct certain informalities. Reconsideration is respectfully requested.

***Rejection under 35 USC § 112***

The Examiner has rejected claims 18 and 20 under 35 USC § 112, second paragraph, for allegedly being indefinite. While the Applicant respectfully traverses this rejection, claims 18 and 20 are amended herein. It is believed that the present amendments address and overcome the rejection of claims 18 and 20. As such, it is respectfully requested that the rejection of claims 18 and 20 under 35 USC § 112, second paragraph, be withdrawn.

***Rejection under 35 USC § 102(b) over Fan***

The Examiner has rejected claims 1-5 under 35 USC § 102(b) over Fan et al., US Patent No. 4,963,373. It is believed that the Examiner intended to reject claim 16 over Fan as well, (see the Office Action, page 4, lines 8-9). If such is not the case, please clarify. The Applicant respectfully traverses this rejection.

The Office Action asserts that Fan teaches the addition of calcium to a cooked, dough based product, and that such a teaching anticipates the present claims. The Applicant does not dispute the Examiner's technical assertion that Fan teaches the incorporation of calcium to dough, which is then cooked, but the Applicant strongly disagrees with the legal conclusion that this teaching anticipates claims 1-5 and 16.

Specifically, the present claims are not directed to the simple addition of calcium to foods. Calcium fortification of food and beverage products has been practiced for many years. Claims 1-5 and 16 are directed to a method for reducing the level of acrylamide in a dough-based food product. Fan does not teach a method of reducing acrylamide, in fact, Fan does not even discuss acrylamide. The Examiner does not suggest that Fan teaches acrylamide reduction in foods, rather the Examiner dismisses the claim's preamble and gives it no consideration for purposes of patentability.

While there are certainly cases where the preamble of a claim does not limit the claim, such is not the case here. From the Title of The Invention, to the Claims and the Abstract, every aspect of the present case is directed to the reduction of acrylamide in cooked foods. No other reading of the present claims and specification is credible. As such, the preamble breathes 'life, meaning and vitality' into the present claims. And as such, the preamble is entitled to patentable weight.

"If the claim preamble, when read in context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999)

If the preamble is given patentable consideration, as it should under the applicable Federal Circuit case law, then claims 1-5 and 16 are not anticipated by Fan. As such, the Applicant respectfully requests that the present rejection be withdrawn.

***Rejection under 35 USC § 102(e) over Walsh***

The Examiner has rejected claims 1-7, and 18 under 35 USC § 102(e) over Walsh et al., US Patent No. 6,607,777 B1. The Applicant respectfully traverses this rejection.

The Office Action asserts that Walsh teaches the addition of calcium to a cooked, dough based product, and that such a teaching anticipates the present claims. The Applicant does not dispute the Examiner's technical assertion that Walsh teaches the incorporation of calcium to dough, which is then cooked, but the Applicant strongly disagrees with the legal conclusion that this teaching anticipates claims 1-7 and 18.

Specifically, the present claims are not directed to the simple addition of calcium to foods. Calcium fortification of food and beverage products has been practiced for many years. Claims 1-7 and 18 are directed to a method for reducing the level of acrylamide in a dough-based food product. Walsh does not teach a method of reducing acrylamide, in fact, Walsh does not even discuss acrylamide. The Examiner does not suggest that Walsh teaches acrylamide reduction in foods, rather the Examiner dismisses the claim's preamble and gives it no consideration for purposes of patentability.

While there are certainly cases where the preamble of a claim does not limit the claim, such is not the case here. From the Title of The Invention, to the Claims and the Abstract, every aspect of the present case is directed to the reduction of acrylamide in cooked foods. No other reading of the present claims and specification is credible. As such, the preamble breathes 'life, meaning and vitality' into the present claims. And as such, the preamble is entitled to patentable weight.

"If the claim preamble, when read in context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999)

If the preamble is give patentable consideration, as it should under the applicable Federal Circuit case law, then claims 1-7 and 18 are not anticipated by Walsh. As such, the Applicant respectfully requests that the present rejection be withdrawn.

***Rejection under 35 USC § 102(b) over Baisier***

The Examiner has rejected claims 8-12, 14-15 and 17 under 35 USC § 102(b) over Baisier et al., US Patent No. 5,279,840. The Applicant respectfully traverses this rejection.

The Office Action asserts that Baisier teaches the steps of coating raw potatoes with a mixture comprising amylose and calcium. The potatoes are then blanched, dried, and fried. The Examiner further asserts that such a teaching anticipates the present claims. The Applicant does not dispute the Examiner's technical assertion that Baisier teaches the incorporation of calcium onto a potato product, which is then cooked, but the Applicant strongly disagrees with the legal conclusion that this teaching anticipates claims 8-12, 14-15 and 17.

First off, claim 8 and the claims depending therefrom, are directed to:

"A method for reducing the level of acrylamide in a food product, comprising adding a water soluble multivalent cation to said food product before heating, wherein said water soluble multivalent cation is selected from the group consisting of zinc, magnesium, copper, aluminum, or mixtures thereof."

Calcium is not listed as one of the multivalent cations and the Examiner makes no assertion that Baisier teaches any cations other than calcium. As such, the present rejection under § 102(b) is flawed and must be withdrawn.

Moreover, the present claims are not directed to the simple addition of multivalent cations to food. Claims 8-12, 14-15 and 17 are directed to a method for reducing the level of acrylamide in a dough-based food product. Baisier does not teach a method of reducing acrylamide, in fact, Baisier does not even discuss acrylamide. The Examiner does not suggest that Baisier teaches acrylamide reduction in foods, rather the Examiner dismisses the claim's preamble and gives it no consideration for purposes of patentability.

While there are certainly cases where the preamble of a claim does not limit the claim, such is not the case here. From the Title of The Invention, to the Claims and the Abstract, every aspect of the present case is directed to the reduction of acrylamide in cooked foods. No other reading of the present claims and specification is credible. As such, the preamble breathes 'life, meaning and vitality' into the present claims. And as such, the preamble is entitled to patentable weight.

"If the claim preamble, when read in context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning and

vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999)

If the preamble is give patentable consideration, as it should under the applicable Federal Circuit case law, then claims 8-12, 14-15 and 17 are not anticipated by Baisier. As such, the Applicant respectfully requests that the present rejection be withdrawn.

***Rejection under 35 USC § 102(e) over Villagran***

The Examiner has rejected claims 8, 13 and 20 under 35 USC § 102(e) over Villagran et al., US Patent No. 6,599,547 B1. The Applicant respectfully traverses this rejection.

The Office Action asserts that Villagran teaches the steps of making a comminuted potato product that comprises the steps of cooking the potato, forming a wet mash from the cooked potato, adding a water soluble cation to the mash and drying the mash. The Examiner further asserts that such a teaching anticipates the present claims. The Applicant does not dispute the Examiner's technical assertion that Villagran teaches the incorporation of calcium onto a potato product, but the Applicant strongly disagrees with the legal conclusion that this teaching anticipates claims 8, 13 and 20.

First off, claim 8 and the claims depending therefrom, are directed to:

"A method for reducing the level of acrylamide in a food product, comprising adding a water soluble multivalent cation to said food product before heating, wherein said water soluble multivalent cation is selected from the group consisting of zinc, magnesium, copper, aluminum, or mixtures thereof."

Calcium is not listed as one of the multivalent cations and the Examiner makes no assertion that Villagran teaches any cations other than calcium. As such, the present rejection under § 102(b) is flawed and must be withdrawn.

Moreover, the present claims are not directed to the simple addition of multivalent cations to food. Claims 8, 13 and 20 are directed to a method for reducing the level of acrylamide in a dough-based food product. Villagran does not teach a method of reducing acrylamide, in fact, Villagran does not even discuss acrylamide. The Examiner does not suggest that Villagran teaches acrylamide reduction in foods, rather the Examiner dismisses the claim's preamble and gives it no consideration for purposes of patentability.

While there are certainly cases where the preamble of a claim does not limit the claim, such is not the case here. From the Title of The Invention, to the Claims and the Abstract, every aspect of the present case is directed to the reduction of acrylamide in cooked foods. No other reading of the present claims and specification is credible. As

such, the preamble breathes ‘life, meaning and vitality’ into the present claims. And as such, the preamble is entitled to patentable weight.

“If the claim preamble, when read in context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999)

If the preamble is given patentable consideration, as it should under the applicable Federal Circuit case law, then claims 8, 13 and 20 are not anticipated by Villagran. As such, the Applicant respectfully requests that the present rejection be withdrawn.

***Rejection under 35 USC § 103(a) over Villagran***

The Examiner has rejected claim 21 under 35 USC § 103(a) over Villagran et al., US Patent No. 6,599,547 B1. The Applicant respectfully traverses this rejection.

The Examiner asserts that Villagran teaches, in addition to the teachings discussed above, the addition of acid to the potato mash. Further, the Examiner asserts that the choice of lactic acid would be obvious to a skilled artisan. But Villagran does not teach or suggest any method for the reduction of acrylamide in a cooked food product, as is discussed above. As such, the present rejection fails for the same reasons argued above. Accordingly, Applicant respectfully requests that the present rejection be withdrawn

***Rejection under 35 USC § 103(a) over Walsh***

The Examiner has rejected claims 19 under 35 USC § 103(a) over Walsh et al., US Patent No. 6,607,777 B1. The Applicant respectfully traverses this rejection.

The Examiner asserts the choice of lactic acid would be obvious to a skilled artisan in light of Walsh’s teaching of soluble and insoluble calcium. But Walsh does not teach or suggest any method for the reduction of acrylamide in a cooked food product, as is discussed above. As such, the present rejection fails for the same reasons argued above. Accordingly, Applicant respectfully requests that the present rejection be withdrawn

Respectfully submitted,

By   
Steven R. Chuey  
Attorney for Applicant  
Registration No. 39,140  
(513) 634-0102

Date: June 13, 2005